



#8/Appeal
Brief
1-30-02

PATENT
03323-P0001C WWW/RJB/TMO

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application Of

Lars Severinsson

Examiner: C. Schwartz

Serial No.: 09/710,962

Group Art Unit: 3613

Filed: November 10, 2000

For: Disc Brake Caliper

RECEIVED
JAN 24 2002
GROUP 3600

Appeal Brief Under 37 C.F.R. §1.192

Commissioner for Patents
and Trademarks
Washington, D.C. 20231

Dear Sir:

Having filed herewith a Notice of Appeal from the final rejection of claims 25-28, all of the claims currently pending, the final rejection being mailed on May 3, 2001, Appellant submits its Appeal Brief for the above-captioned application pursuant to 37 C.F.R. §1.192 in triplicate as follows.

Certificate of Mailing: I hereby certify that this correspondence is today being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents and Trademarks; Washington, DC 20231.

November d, 2001

Linda A. Ferranti

Real Party in Interest

The real party in interest is Haldex Brake Products Aktiebolag, residing at Instrumentgatan 15; Box 501; SE-261 24 Landskrona; SWEDEN.

Related Appeals and Interferences

There are no related appeals or interferences.

Status Of Claims

Claims 25-28 are currently pending, stand rejected and are the subject of the instant Appeal. A copy of each of these claims is attached hereto as Exhibit A.

Status Of Amendments

Subsequent to the Final Rejection being mailed on May 3, 2001, Appellant filed an Amendment After Final on September 24, 2001. The Amendment After Final asked the Examiner to reconsider his position, and addressed formal reissue matters (including providing missing formal documents), but did not amend the claims in any way.

Summary Of Invention

As described in the specification, Appellant discloses and claims a disc brake caliper including a housing (1) to be arranged to straddle a vehicle brake disc, and a preassembled brake mechanism held together as a unit inserted within housing (1). The preassembled brake unit includes a lever (17) for transmitting a brake force from a brake cylinder (4), attached to the caliper, to a cross bar. The lever has a curved wedge (19) with two cylindrical surfaces (19', 19") in engagement with corresponding cylindrical surfaces of bearing tappets (20) and the cross bar, respectively. An adjuster mechanism (28) is arranged on a splined shaft (29) rotatably journaled in the bearing tappets..

References Cited And Applied

There are no references cited and applied.

Grounds Of Rejection

Claims 25-28 stand rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

Issues Presented For Review

Whether the presence of an element (i.e., the cover) is considered surrendered subject matter (in the context of evaluating the presence of impermissible recapture) when the element itself was not added, and no arguments about the presence of the element itself were made, in an effort to overcome a prior art rejection.

Grouping of Claims

The claims stand or fall together, as none of the claims require a cover, which is the element at issue.

Argument

In an Office Action mailed on February 15, 2000 during prosecution of the parent to the present application, 08/817769 (now RE37231), Examiner Schwartz rejected amended claim 16 of the parent application, which is identical to claim 25 of the present application, under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,433,298 to Antony et al. Appellant filed a Response on April 12, 2000, requesting that the Examiner reconsider his position and highlighting the novel aspects of the invention over the cited prior art. Thereafter, Examiner Schwartz telephoned the undersigned, to inform him that although Examiner Schwartz had determined that Claim 16 was patentable

over the references of record, and had attempted to issue a Notice of Allowability, a reissue supervisor at the U.S. Patent Office had instructed Examiner Schwartz not to issue the Notice of Allowability, and instead reject Claim 16 under the theory of impermissible recapture. In response to this telephone conversation, Appellant amended Claim 16 to remove any question of recapture so as not to delay the issuance of the parent application. Appellant filed the present application, with Claim 25 of the present application being identical to Claim 16 of the parent case before having been amended to remove any question of recapture.

For the foregoing reasons, Appellant respectfully submits that any questions of patentability with respect to the prior art have already been resolved, and that the only outstanding issue presented in this Appeal relates to the recapture allegation.

The recapture rule comprises a two part test. The first step is to "determine whether and in what aspect the reissue claims are broader than the patent claims." *In re Clement*, 131 F.3d 1464, 1468 (Fed. Cir. 1997). This step requires focusing on, for example, deleted limitations in the reissue claims that were present in the original patent claims. In this respect, the claims as a whole are broader only with respect to the elements having the deleted or broadened limitations. The remaining elements should be interpreted to have the same scope as the issued claims.

In the present application, the Examiner has asserted that the current claims are broader in that the present reissue claims do not require a cover. Appellant agrees with the Examiner on this point.

The second step is to “determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an Appellant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.” *In re Clement*, 131 F.3d 1464, 1468-69 (Fed. Cir. 1997) citing *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995-96 (Fed. Cir. 1993).

Appellant respectfully suggests that the cover does not relate to surrendered subject matter, as the cover itself was not added and no arguments about the presence of the cover itself were made in an effort to overcome a prior art rejection.

Appellant notes the Examiner’s citation of the specification, page 2, line 29: “...but the cover and the rest of the mechanism are also **held together as a unit...**”. Appellant also notes the Examiner’s citation of page 6 of Appellant’s remarks in the original parent case 08/817769 (now RE37231): “Parent claim 1 is amended to better structurally define Applicant’s novel feature wherein the housing and cover members are structured with the entire braking unit carried by

the cover independently from the housing to be inserted as a unit." The Examiner has apparently construed these statements to mean that a cover is required as part of the novelty of the invention. Appellant respectfully disagrees.

As the Examiner has himself noticed (as indicated by his highlighting of the phrase in the quoted portion of the specification), the novelty of the invention is that the brake mechanism is "held together as a unit." Similarly, Appellant suggests that the relevant phrase of the quoted portion of Appellant's remarks in the original parent case 08/817769 (now RE37231) is as follows: that the braking unit be separate "from the housing to be inserted as a unit". This interpretation is supported by a reading of Appellants arguments as a whole for patentability in its previous responses to office actions. Appellant consistently argued for patentability on the basis that the brake mechanism be held together as a unit.

The presence of the cover itself was never asserted to contribute to patentability, and indeed it could not have been since the prior art clearly disclosed a brake system having a housing and a cover (see for example U.S. Patent No. 5,927,445 to Bieker, which was brought to the Examiner's attention in the present application via an IDS). Thus, it was Appellant's assertion that a preassembled brake mechanism held together as a unit was patentable. That the preassembled brake mechanism must include a cover was not argued as making the invention patentable, and indeed was not what made the invention

patentable. As such, removal of the cover in the present application does not constitute impermissible recapture, as the cover does not relate to surrendered subject matter. If the cover was present, it would form part of the preassembled brake mechanism -- however, there was no argument made that the cover itself was required for novelty or somehow distinguished over the prior art.

In a case similar to the present situation, where the Federal Circuit concluded a patentee was not attempting to recapture subject matter and allowed the reissue claims, the court determined that the patentee added a "plurality of feedlines" in an effort to overcome prior art, but that a cylindrical configuration limitation was neither added in an effort to overcome a prior art rejection nor argued to distinguish the claims from a reference. *Ball Corp. v. United States*, 729 F.2d 1429, 1437 (Fed. Cir. 1984). As discussed above, the cover here, although clearly present in the claims of the original patent, was neither added in an effort to overcome prior art nor argued to distinguish the claims from a prior art reference. "Recapture rule may not apply if reissue claim is broader in a manner that does not attempt to reclaim what was surrendered earlier..." *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 992 (Fed. Cir. 1993).

Moreover, the Examiner has already expressed that claims directed to the wedge configuration are patentable over the prior art without the inclusion of a cover.

Conclusion

Appellant has made a significant advance over the prior art by providing a less complex, less expensive and more reliable disc brake caliper than has heretofore been known. Accordingly, reconsideration and allowance of all pending claims is believed in order, and such action is earnestly solicited.

Respectfully submitted,

October 30, 2001

Todd M. Oberdick
Wesley W. Whitmyer, Jr., Registration No. 33,558
Richard J. Basile, Registration No. 40,501
Todd M. Oberdick, Reg. No. 44,268
ST. ONGE STEWARD JOHNSTON & REENS
986 Bedford Street
Stamford, Connecticut 06905
(203) 324-6155

Attorneys for Appellant

EXHIBIT A - Pending Claims

25. A disc brake caliper system comprising a housing (1) to be arranged astraddle of a vehicle brake disc, two thrust sleeves (8), which are connected to a brake pad holder (6) provided with a brake pad (5) for braking engagement with the brake disc and which are axially movable in the housing at a distance from each other, a cross bar (9) connecting the two thrust sleeves, and a lever (17) for transmitting a brake force from a brake cylinder (4) attached to the housing, to the cross bar, characterized in that the mechanism including the thrust sleeves (8), the cross bar (9) and the lever (17) is a self-sustained unit for insertion in the housing (1) and further characterized in that bearing tappets (20), parallel with the cross bar (9), are fixedly connected to the inside of the housing (1) and in that the lever (17), besides an arm (18) for actuation by the brake cylinder (4), comprises a curved wedge (19), having an inner cylindrical surface (19') in engagement with outer cylindrical surfaces of the bearing tappets and an outer cylindrical surface (19'') -- with greater radius than the inner cylindrical surface -- in engagement with an inner cylindrical surface of the cross bar.
26. A mechanism according to Claim 25, characterized in that an adjuster mechanism (28) is arranged on a splined shaft (29) rotatably journaled in the bearing tappets (20).
27. A mechanism according to Claim 26, characterized in that the adjuster mechanism (28) is arranged between the two bearing tappets (20).

28. A mechanism according to Claim 27, characterized in that an adjuster housing (33) of the adjuster mechanism (28) is provided with external gears in engagement with a gear wheel (41) rotatably journaled in the housing (1), the gear wheel (41) in turn being in engagement with an internal gear segment (17") in an arcuate yoke (17') of the lever (17).